

U.S.S.N. 09/966,581
Response dated May 11, 2004
Reply to Office Action dated February 25, 2004

REMARKS

Claims 20-35 are pending in the application. In the Final Office Action of February 25, 2004, claims 20-35 were finally rejected as anticipated under § 102(a) or obvious under § 103(a) over Jung et al., Anal. Chem. 73:3759-3767 (2001) ("Jung"). The obviousness rejections include citations to secondary references (U.S. Patent No. 5,762,770 to Pritchard et al., U.S. Patent No. 5,643,721 to Spring et al., or U.S. Patent No. 6,062,225 to Keefe et al.), but all rely on Jung as the primary reference. Accordingly, as argued in detail in the Amendment filed on January 5, 2004, if Jung were removed as prior art, all of the outstanding rejections would be overcome and the claims would be allowable.

Applicants maintain that Jung is not prior art with respect to the present application, because Jung was published less than one year prior to the application's filing date, and Jung's disclosure represents the inventive work of co-inventors of the application. The authors of the Jung reference are Sung-Kwon Jung, Peter J.S. Smith, Richard H. Sanger, and James R. Trimarchi. The inventors of the present application are Sung-Kwon Jung, Peter J.S. Smith, Richard H. Sanger, and John R. Pepperell. On January 5, 2004, Applicants submitted a Declaration of Drs. Jung, Smith, Sanger, and Pepperell under 37 C.F.R. § 1.132, stating that the subject matter disclosed in the Jung reference represents the inventive work of Drs. Jung, Smith, and Sanger. The Declaration states that Dr. Trimarchi, the fourth co-author of the Jung reference, did not make an inventive contribution to the subject matter of the present application, and that Dr. Pepperell, although not a co-author of the Jung reference, is a co-inventor of subject matter disclosed and claimed in the application. The inventors' Declaration establishes that Jung does not qualify as prior art to the present application. Accordingly, Applicants respectfully submit that all of the outstanding prior art rejections should be reconsidered and withdrawn.

In the Final Office Action of February 25, 2004, the Examiner stated that the inventors' Declaration established that Dr. Trimarchi is not a co-inventor. However, the Examiner opined that Jung still qualifies as prior art (i.e., the work of "others") because Dr. Pepperell is a co-inventor, but not an author of the Jung reference.

Applicants thank the Examiner for the courtesy of a telephone call with the undersigned and Michael Twomey on April 28, 2004. In the telephone call, Applicants' representatives explained that the inventors' Declaration is sufficient to remove the Jung reference as prior art, citing *Ex parte Kroger*, 219 U.S.P.Q. 370 (Bd. Pat. App. Int. 1982), as discussed at MPEP

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§ 2132.01. A copy of the *Kroger* case is submitted herewith. The Examiner agreed to review *Kroger*, and indicated that if the inventors' Declaration is sufficient to remove the Jung reference as prior art, then all of the outstanding rejections would be overcome and the claims would be allowable.

Applicants respectfully submit that *Ex parte Kroger*, as discussed at MPEP § 2132.01, demonstrates that the inventors' Declaration in the present application is sufficient to remove Jung as prior art. *Kroger* involved a rejection under § 102(f),¹ but was otherwise factually similar to the present case, with an application to Kroger and Rod being rejected over a publication by Kroger, Knaster, and others. As in the present case, the cited publication included an author (Knaster) who was not a named co-inventor on the application, while one of the co-inventors of the application (Rod) was not an author of the cited publication. The Board of Patent Appeals and Interferences explained that "various declarations were submitted by Kroger and Rod to the effect that Kroger and Rod are the inventors and that Knaster merely carried out assignments and worked under the supervision and direction of Kroger." *Kroger*, 219 U.S.P.Q. 370 at 371. Similarly, in the present application, a declaration was submitted by Drs. Jung, Smith, Sanger, and Pepperell stating that they are the inventors, and that Dr. Trimarchi, although an author on the Jung paper, did not make an inventive contribution to the subject matter of the application. In *Kroger*, the Board found that "if this were all the evidence in the case, then we would be constrained to agree that Kroger et al are the inventors and that Knaster is not a coinventor." *Kroger*, 219 U.S.P.Q. 370 at 371-372 (emphasis added). However, the Board found that further evidence beyond Kroger's and Rod's declarations would be required to remove the cited publication as prior art in that case, because the co-author Knaster had asserted that he was a co-inventor of the application, and had introduced supporting evidence to this effect. No such contradictory assertions or evidence exist in the present application. Indeed, the Examiner has already found that the inventors' Declaration removed all issues with respect to Dr. Trimarchi, the only co-author of the Jung reference who is not also named as a co-inventor of the application. Therefore, the Board's primary reasoning in *Kroger* applies, and the inventors' Declaration is sufficient to remove Jung as prior art.

¹ The discussion of *Ex parte Kroger* in MPEP § 2132.01 notes that the Board treated the prior art issue the same as if the rejection had arisen under § 102(a).

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Conclusion

The above arguments and the previously-submitted inventors' Declaration establish that the Jung reference, which forms the basis for all of the outstanding claim rejections, is not prior art to the present application. The Examiner has agreed that if Jung were removed as prior art, then all of the rejections contained in the Final Office Action mailed on February 25, 2004 would be overcome, and all of the pending claims should be in condition for allowance. Accordingly, Applicants respectfully request timely reconsideration and withdrawal of the outstanding rejections, and issuance of a Notice of Allowance.

No fees are believed to be due in connection with this correspondence. However, please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

Respectfully submitted,

Date: 5/11/04

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 (Cite as: 219 U.S.P.Q. 370)

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Ex parte Kroger and Rod

*371 Appeal from Art Unit 112.

Patent and Trademark Office Board of Appeals

Opinion dated Nov. 22, 1982

United States Patents Quarterly Headnotes

PATENTS

[1] Applicants for patent -- In general (§ 14.1)

Authorship of article, by itself, does not raise presumption of inventorship with respect to subject matter disclosed in article; however, it is incumbent upon applicants to provide satisfactory showing that would lead to reasonable conclusion that they are inventors and that non-applicant-coauthor is not coinventor.

Application for patent of Ferdinand A. Kroger and Robert L. Rod, Serial No. 899,227, filed Apr. 24, 1978, continuation-in-part of application, Serial No. 883,150, filed Mar. 3, 1978, continuation of application Serial No. 693,890, filed June 8, 1976. From rejection of claims 43, 60-79, 84-90, and 93-96, applicants appeal (Appeal No. 442-64). Affirmed.

Edwin A. Oser, Pacific Palisades, Calif., for appellants.

Before Magil, Serota, and Katz, Examiners-in-Chief.

Katz, Examiner-in-Chief.

PATENTS

[2] Applicants for patent -- In general (§ 14.1)

Application by two coauthors of reference publication whose coauthor refused to sign declaration to effect that he was not coinventor, and who introduced evidence in form of letter to PTO in which he declares himself to be coinventor with applicants goes beyond dictates of In re Katz, 215 USPQ 14, and requires further evidence before Board of Appeals can come to conclusion that present applicants are the only inventors of claimed subject matter; since board is not body of inquiry, board that is of opinion that all evidence has not been developed, can make no decision that present inventors are only inventors of claimed subject matter and that evidence presented by that publication has been overcome; accordingly, rejection under 35 USC 102(f) in view of publication is affirmed.

This is an appeal from the final rejection of claims 43, 60 to 79, 84 to 90 and 93 to 96. By the paper of April 6, 1982, appellants have withdrawn the appeal as to claims 46 to 48, 50, 51, 55 to 59 and 97 to 103. Claims 81 to 83, 91, 92 and 104 have been allowed. Claims 70 and 71 have been objected to as depending on rejected claims and, presumably, would be allowed if placed in independent form.

Claim 43 reads as follows:

43. A method of preparing a photo-voltaic power generating cell comprising:

depositing electrochemically on a suitably prepared metal electrode adapted to form a Schottky barrier a coating of a semiconductor compound from an electrolytic bath including the components of said semiconductor compound, said compound being capable of forming a Schottky barrier with said electrode, being transmissive to light radiation and being capable of forming electron-hole pairs upon being irradiated with photons, said components being formed of at least one of the metal elements of Class 11B and non-metal elements

PATENTS

Particular patents--Photo-Voltaic Power Application

Kroger and Rod, Photo-Voltaic Power Generating Means and Methods, rejection of claims 43, 60-79, 84-90, and 93-96 affirmed.

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219 U.S.P.Q. 370
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of Class VIA of the Periodic Table of elements.

The claimed invention relates to a method for preparing a photo-voltaic power generating cell. The details of the technical aspects of the invention are not important in this case since the only issue before us is one dealing with whether the named inventors invented the subject matter sought to be patented, as required under 35 USC 102(f).

The reference relied on is:

Panicker et al, J. ELECTROCHEM. SOC.: ELECTROCHEMICAL SCIENCE AND TECHNOLOGY, "Cathodic Deposition of CdTe from Aqueous Electrolytes," Vol. 125, pp. 566-572, April 1978.

All the claims on appeal stand rejected under 35 USC 102(f) in view of the Panicker et al publication.

We have carefully considered the arguments in this case and find that we agree with the examiner substantially for the reasons set forth in the Answer. We add the following in order to introduce and distinguish from the newly decided case of In re Katz, 215 USPO 14 (CCPA 1982).

[1] This case follows all the prerequisites for proving inventorship of the named applicants in spite of a previous publication which includes the named applicants (except Rod) and the inclusion of Knaster. As held in In re Katz, the authorship of an article, by itself, does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Accordingly, we will not infer that, merely because Knaster is mentioned as one of the authors, Knaster is also one of the inventors of the subject matter set forth in the article. However, as stated in Katz, it is incumbent upon appellants to provide a satisfactory showing which would lead to a reasonable conclusion that they are the inventors and that Knaster is not a coinventor. In line with this, various declarations were submitted by Kroger and Rod to the effect that Kroger and Rod are the inventors and that Knaster merely carried out assignments and worked under the supervision and direction of Kroger.

[2] If this were all the evidence in the case, then we would be constrained to agree that *372 Kroger et al are the inventors and that Knaster is not a coinventor. However, this case distinguishes from In re Katz in that Knaster has refused to sign a

declaration submitted to him by the attorneys for the present applicants, which declaration is to the effect that Knaster is not a coinventor. Also, Knaster has introduced evidence into the case in the form of a letter to the Patent and Trademark Office in which he declares himself to be a coinventor with the present applicants. Accordingly, we consider that this application goes beyond the dictates of In re Katz and requires further evidence before we can come to a conclusion that the present applicants are the *only* inventors of the claimed subject matter.

Since we are not a body of inquiry and since we are of the opinion that all the evidence has not been developed, we can make no decision that the present inventors are the only inventors of the claimed subject matter and that the evidence presented by the Panicker et al publication has been overcome. Accordingly, we will affirm the present rejection.

We call attention to In re Facius, 56 CCPA 1348, 408 F.2d 1396, 161 USPO 294 (1969); In re Mathews, 56 CCPA 1033, 408 F.2d 1393, 161 USPO 276 (1969); and In re Carreira et al, 532 F.2d 1356, 189 USPO 461 (CCPA 1976). In these cases, which relate to an analogous problem of proving inventorships in spite of prior patents, it was held (see especially In re Carreira et al) that not only must the patentee disclaim inventorship of the subject matter claimed by appellant but patentee must also state that he derived the relevant subject matter from the appellant. In other words, the patentee must disclaim the subject matter and attribute it to the applicant. The reasoning in that case was that merely disclaiming the subject matter would not be sufficient since there was no proof that the patent subject matter was not disclosed to patentee by a third person rather than by the appellant.

Since the In re Katz holding is not deciding in this case, we would fall back on the earlier cases, including In re Carreira et al and hold that the evidence presented in the Panicker et al publication has not been overcome. Not only have the authors (essentially only Knaster) not disclaimed the subject matter and attributed their published information to the present applicants but no affidavit or declaration along these lines has been submitted.

The decision of the examiner is affirmed.

Affirmed.

P.T.O. Bd.App.

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